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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/894,824	08/29/97	FRIEBE	R BAYER9930-WC

15M2/1212
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EXAMINER
GLASS, M

ART UNIT	PAPER NUMBER
1501	5

DATE MAILED:

12/12/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/894,824

Applicant(s)
Friebe et al.

Examiner
Margaret Glass

Group Art Unit
1501



☒ Responsive to communication(s) filed on Aug 29, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) 11 and 12 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-13 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 to 10 and 13, drawn to a composition.

Group II, claim(s) 11 and 12, drawn to a surface modified filler.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the filler of claim 11 does not require the necessary silicone composition components as required in claim 1 and the silicone composition claims do not require the surface modified filler of claim 11.

2. During a telephone conversation with William Gerstenzang on 12/2/97 a provisional election was made without traverse to prosecute the invention of Group I, claims 1 to 10 and 13. Affirmation of this election must be made by applicant in responding to this Office action. Claims 11 and 12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

4. Claims 1 to 10 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

invention. The term substituted on its own without further definition, as in the instant application, is considered non-enabled. The instant application provides no express statement or description in the specification to teach one skilled in the art that all substituents, organic and/or inorganic, are properly within the subject matter applicants consider to be the invention. There is no description nor sufficient representative examples which may provide a basis for such terminology to satisfy the description requirements of the first paragraph of 35 U.S.C. 112. The disclosure does not enable one to practice the invention as broadly as it is claimed without undue experimentation since there is no guide as to which of the vast array of substituents are suitable for the intended purpose. Applicants may argue that the claims are inclusive of all substituents that would be suitable, but there are no guidelines set forth as to which of the countless substituents are included. It should not be left to the ordinary artisan to determine by undue experimentation whether a particular substituent is or isn't suitable and thus possibly within the scope of the claim.

5. Claims 1 to 10 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1:

In d) R¹ and R² are not defined. If they are supposed to have the same definition as in a) this should be explicitly stated to avoid confusion, i.e. "... can be the same or different within the molecule and are as defined above".

If is unclear what is embraced by "optionally other auxiliary substances" since it is unclear what is intended by "auxiliary".

Claim 7:

It is unclear what is included by this term "catalysts" since e) already embraces catalysts.

Claim 13:

The "use" claim is indefinite since it is not clear what is intended by this term. Note that "use" is not a statutory field of invention. The Examiner suggests that this claim be reworded

such that it is drawn to a sealant, adhesive or coating composition which contains the polysiloxane composition of claim 1.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 to 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi et al. in view of Kimura et al.

Wakabayashi et al. teach a curable composition comprising an organic polymer having hydrolyzable silyl terminal groups, a phosphorus compound, a zirconium compound, optionally a filler which can be a basic filler and a pot life improver which can be a silane compound such as methyltriethoxysilane, vinyl trimethoxysilane or tetraethyl silicate. Thus the composition of Wakabayashi et al. explicitly includes the claimed compounds c) and e) and suggests the addition of b) and d) to improve the pot life other properties. This composition differs in that it does not specify a crosslinkable polysiloxane, the claimed component a). The main crosslinkable polymer has a back bone such as polyether.

Kimura et al. teach curable compositions which cure in the presence of moisture via a condensation reaction, the same cure mechanism of Wakabayashi et al. This reference teaches the alternative use of crosslinkable polymers having siloxane and polyether backbones. As such one having ordinary skill in the art would have been motivated by this alternative use to use a siloxane backbone containing polymer in the curable composition of Wakabayashi et al. with a reasonable expectation of success. Thus this the claimed composition appears obvious over this combination of teachings.

Regarding the limitation of claim 4, note that such a phosphorus compound is used in the examples of Wakabayashi et al. Also note that the examples use phosphorus compounds which are organic titanium compounds, thus meeting the requirement of claim 6. Column 9 teaches that

the order of addition of each component is not critical, placing the mixing order within routine experimentation for the skilled artisan and thus rendering obvious the limitation of claim 10.

8. Claims 1 to 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiller et al. in view of Sattlegger et al.

Schiller et al. teach organopolysiloxane compositions containing a siloxane having terminal reactive groups, a phosphorus compound and a filler. These compositions can optionally contain an organic tin compound as a condensation catalyst and adhesion promoters. Note Examples 1 and 5. Example 1 differs from that claimed in that 1) it does not contain alkoxysilane compound d) and 2) it does not contain a organometallic compound. Example 5 differs from that claimed in that 1) it does not contain alkoxysilane compound d) and 2) the chalk is stearic acid treated which would appear to render it non-basic. The differences 2) are obvious in view of the teachings of Schiller et al. which teaches the use basic fillers and organometallic condensation catalysts.


Sattlegger et al. teaches a composition similar to that of Schiller et al. in which a moisture curable composition has improved adhesion through the addition of an alkoxysilane compound, applicants' claimed d). As such one having ordinary skill in the art would have been motivated to add such a known adhesion promoter to the composition of Schiller et al. in an effort to obtain the known benefits and properties thereof. Also note that these compounds are known to improve the pot life of such curable compositions, providing the skilled artisan with additional motivation to add such silanes to the composition of Schiller et al.. This renders obvious the differences 1) noted supra and as such renders the claimed composition as a whole obvious over this combination of references. With regards to the process claim 10, note that the order of addition of each component is not critical and adjusting the order such that the basic filler and the phosphorus compound are preliminarily mixed would have been well within the skill of the ordinary artisan.

9. Innertsberger et al. teach that phosphoric acid esters are known plasticizers in organometallic condensation catalyst cured R.V. silicone compositions.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Glass whose telephone number is (703) 308-4334.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

Any **official** documents can be faxed to the Crystal Mall FAX Center at (703) 305-5433 or 305-5408. Please do not send any informal communication or proposed amendments to this number.


Margaret Glass
Primary Examiner
Group 1500, Art Unit 1501

mwg
December 3, 1997